

REMARKS

Status of the Claims

Claims 1, 2, 13-15, 23-29, 43, 44, 54-56, 58, 65 and 67 are pending and are at issue. Claims 24, 27 and 28 are amended herewith. Claims 3-12, 16-22, 30-42, 45-53, 57, 59-64, 66, and 68-70 were previously cancelled. Claims 54-56, 58, 65 and 67 have been withdrawn from consideration.

Rejection under 35 U.S.C. 102(a)/103(a)

Claims 1, 2, 13-15, 23-25 and 43-44 are rejected under 35 U.S.C. § 102(a) as anticipated by or alternatively as obvious under 35 U.S.C. § 103(a) over Toki (WO2003-014022). The Examiner contends that Toki teaches a dispersed ingredient or a dispersoid having metal-oxygen bonds obtained by hydrolyzing or a partially hydrolyzing a metal alkoxide in the absence of an acid, base, and dispersion stabilizer.

The rejection is respectfully traversed, and reconsideration is requested.

To be available under 35 U.S.C. § 102(a)/103(a), a patented or printed publication must describe the invention “before the invention thereof by the applicant for patent.” Toki lists the following as applicants/inventors: Motoyuki Toki, Akiji Higuchi, Nobuo Kimura, and Yoshitaka Fujita and is assigned to Nippon Soda Co. Ltd. Each of these applicants is an inventor on the present application, which is also assigned to Nippon Soda Co. Ltd.

Since each of the authors of Toki is an inventor in the present application, the invention was not conceived “before the invention thereof by the applicant for patent.” Thus, Toki is unavailable as prior art under 35 U.S.C. § 102(a)/103(a) and applicants respectfully request that this rejection of claims 1, 2, 13-15, 23-25 and 43-44 be withdrawn.

Rejection under 35 U.S.C. 102(b)/103(a)

Claims 27 - 29 stand rejected under 35 U.S.C. § 102(b) as anticipated by or alternatively as obvious under 35 U.S.C. § 103(a) over U.S. Pat. 6,235,260 to Toki (the ‘260 patent). The Examiner argues that the ‘260 patent teaches a dispersoid, having metal-oxygen

bonds, such as tin or indium oxide, and that the dispersoid is obtained by mixing a metal compound having at least three hydrolysable groups where the water is added in divided portions. The Examiner also states that the recitations of steps of water addition are process step limitations that are not considered to provide structural limitations to the product.

The rejection is respectfully traversed, and reconsideration is requested.

As presently pending, claims 27 and 28 recite the limitation, "...in the absence of all members selected from the group consisting of an acid, a base and a dispersion stabilizer." These amendments specify all of the following are excluded: the presence of an acid, the presence of a base, the presence of a dispersion stabilizer, the presence of an acid and a base, the presence of an acid and a dispersion stabilizer, the presence of a base and a dispersion stabilizer, and the presence of an acid, a base and a dispersion stabilizer. In contrast, an acid is used in all of the examples in the '260 patent.

In addition, by selecting such a constitution as recited in pending claim 27 or 28, a pH adjustment by addition of an acid, which is needed in the '260 patent, is not required in the dispersoids of this invention. Furthermore, because the dispersoids of this invention have stable structures without agglomeration even in the absence of an acid, a base or a dispersion stabilizer, it is possible to form films that are dense and have a smooth surface on any kind of substrate. Therefore, claims 27 and 28 are both novel and non-obvious over the '260 patent.

Furthermore, because claim 29 is dependent on claim 28, the rejection of claim 29 is overcome for the same reasons as discussed above.

Thus, Applicants respectfully request that this rejection over claims 27 – 29 be withdrawn.

Rejection under 35 U.S.C. 103(a)

Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Pat. 4,801,399 to Clark (Clark) in view of the '260 patent. The Examiner agrees that Clark does not disclose a mixture of hydrocarbon, water, and alcohol, but adds that the '260 patent does.

Claim 26 is rejected as obvious over Clark in view of the '260 patent and further in view of the Handbook of Chemistry and Physics which shows that the recited solvents have unlimited or infinitive solubility in water and each other.

These rejections are respectfully traversed, and reconsideration is requested.

Claim 24 has been amended to add the limitation, "...in the absence of all members selected from the group consisting of an acid, a base and a dispersion stabilizer." The dispersion stabilizer includes a deflocculant (a peptizing agent), as shown, for example, on page 12, line 17 of the specification. Thus, each of the conditions including the presence of an acid and the presence of a deflocculant (a peptizing agent) are excluded from the scope of claim 24. In contrast, an acid is used in all of the examples in the '260 patent, and a peptizing agent is used in all of the examples in Clark.

In addition, by selecting such a constitution of claim 24, the dispersoids as claimed have stable structures without agglomeration even in the absence of an acid, a base or a dispersion stabilizer, it is possible to form films that are dense and have a smooth surface on any kind of substrate. Therefore, claim 24 is not obvious over Clark in view of the '260.

Further, since claim 25 depends from 24, the rejection of this claim is also overcome.

Claim 26 also depends from claim 24. The teachings in the Handbook of Chemistry and Physics does not overcome the deficiencies of the '260 patent and Clark. Thus, the rejection of this claim is also overcome.

Thus, Applicants respectfully request that these rejections of claims 24 – 25 and 26 be withdrawn.

Conclusion

It is believed, for the foregoing reasons that this application is in condition for allowance. Such action is earnestly solicited. If the Examiner believes there are further issues that could be advanced by an interview or entry of an Examiner's Amendment, the Examiner is invited to contact the undersigned attorney.

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